

REMARKS

Pursuant to a Notice of Allowance mailed March 7, 2005, claims 1-20, 25-31 and 38-40 of the present application were allowed and payment of the issue fees was made on March 25, 2005. Subsequent thereto, Applicants became aware of certain references that were identified in the corresponding European patent application and that it would be necessary to disclose the references in the present application for consideration by the Patent Office. Consequently, in addition to the instant Amendment, Applicants have filed a Petition to Withdraw From Issue, which petition has been received by the Office and will be acted on prior to issuance of the patent, a Request for Continued Examination, a Request for Consideration of Information Under 37 CFR § 1.97(c) and an Information Disclosure Statement (IDS), including Form 1449.

The amendment distinguishes claim 1 and all claims dependent thereon from the *Patel et al.* reference identified in the IDS. Additionally, none of the compounds individually claimed in claims 25 and 30, contain the functional groups subject to the proviso. Furthermore, the original definition of  $R^2$  in claim 1 did not include "phenyl," which is required in the structures disclosed in both the *Suto et al.* and *Asano et al.* references identified in the IDS. Finally, in addition to the exclusion from the definition of  $R^2$  those groups that may correspond to structures disclosed in the *Patel et al.* reference, it is observed that *Patel et al.* is directed to a different field of interest, namely inhibitors of human renin, which are said to relate to angiotensin converting enzyme (ACE) inhibition and its consequences affecting hypertension and congestive heart failure. Clearly, the subject matter of *Patel et al.* is distinguished from that of the present invention. Finally, Japanese patent abstract JP-4-001140 is directed to

oxidation of a specified group present in a molecule using a well-known method. The abstract discloses only a portion of a substance having the group (I) subject to such oxidation.

Favorable reconsideration and allowance are earnestly solicited. If, however, for any reason the Examiner does not believe that such action can be taken at this time, it is respectfully requested that he telephone Applicants' attorney at (908) 654-5000 in order to overcome any additional objections which the Examiner might have.

If there are any additional charges in connection with this requested amendment, the Examiner is authorized to charge Deposit Account No. 12-1095 therefor.

Dated: April 12, 2005

Respectfully submitted,

By 

Harvey L. Cohen

Registration No.: 28,365

LERNER, DAVID, LITTENBERG,

KRUMHOLZ & MENTLIK, LLP

600 South Avenue West

Westfield, New Jersey 07090

(908) 654-5000

Attorney for Applicant